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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

555255-012714

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on August 5, 2008

Signature Debra Pejeau

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Application Number

10/817,070

Filed

04/02/2004

First Named Inventor

Michael K. Brown

Art Unit

2132

Examiner

M. P. San Juan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 40,511

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

John V. Biernacki
Signature

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Telephone number

August 5, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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PATENT

Attorney Docket No. 555255012714

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Herbert A. Little; et al.
Serial No. : 10/817,070
Filing Date : 04/02/2004
For : SYSTEM AND METHOD OF ACCESSING KEYS FOR
SECURE MESSAGING
Art Unit : 2109
Examiner : Martin Jeriko P. San Juan

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL REQUEST FOR REVIEW

Sir:

This pre-appeal request for review responds to the Final Office Action mailed on February 5, 2008 and the Advisory Action mailed on June 16, 2008. Independent claims 1, 25, 26, and 27 stand rejected in the Final Office Action under 35 U.S.C. § 103(a) as being obvious over U.S. Publication No. 2002/0169954, application of Bandini et al. (Bandini) in view of U.S. Patent No. 6,782,266, issued to Baer et al. (Baer). Assignee maintains that the rejection of these claims is clearly erroneous because: (I) neither reference teaches providing a reason for a validity check issue via a user interface on a mobile device; and (II) neither reference teaches that the processing performed with respect to a secure message occurs before a message is even sent.

(I) Neither Reference Teaches Providing A Reason For A Validity Check Issue Via A User Interface On A Mobile Device.

Claim 1 of the instant application is directed to a method for handling on a wireless mobile communication device a secure message to be sent from the wireless mobile communication device to a recipient. Claim 1 further recites performing a validity check with respect to using a security key associated with the recipient and, where a validity check issue exists, determining a reason for the validity check issue. The reason for the validity check issue is provided via a user interface on the mobile device.

In rejecting claim 1, the Final Office Action cites paragraph 44 of Bandini as disclosing claim 1's limitations that a reason for a validity check issue is determined and that the reason thus determined is provided via a user interface on the mobile device. The Final Office Action also includes additional text that explains its application of paragraph 44 to the recited claim language. For example with respect to the limitation of determining a reason for the validity check issue, the Final Office Action states, "Notification actions are caused during a given policy being triggered and executed." The Final Office Action explains Bandini's disclosure of claim 1's limitation that recites providing the reason for the validity check issue via a user interface on the mobile device by stating, "The issue is what is being notified." Further, in response to assignee's previously submitted arguments, the Final Office Action "acknowledges" the assignee's concerns that Bandini does not disclose determining a reason for the issue resulting from the validity check. However, the Final Office Action then cites paragraphs 45-47 of Bandini as teaching this limitation of claim 1, stating that the cited paragraphs provide "an example of a policy being triggered which provides further evidence of the extent of information that is included in the annotation and notification actions." The Final Office Action's response to the assignee's argument further states:

In the end of the execution of a policy being triggered, Bandini discloses that “the security manager provides a corresponding result notification to the policy manager so as to facilitate proper follow up actions, such as rejection or acceptance of the e-mail message (Par 0047).” This is evidence of the extent of information that is included in the Annotation, Notification actions of a Policy Manager whenever a policy issue has arisen. The extent of information that is included in the annotation/notification suggests or implies “a reason(s) for any validity check issues,” since “corresponding result notification” would have suggested or implied to include information of any point of failures that have occurred during the execution of a policy, “so as to facilitate proper follow up actions, such as rejection or acceptance of the e-mail message.” (Emphasis original.)

The assignee respectfully disagrees with the office action’s characterization of paragraphs 45-47 of Bandini. The language from Bandini that is quoted in the passage above shows that Bandini does not disclose the subject matter as asserted in the office action. The “result notification” mentioned in Bandini is provided to *the policy manager software module* to facilitate follow-up actions. Even *assuming arguendo* that Bandini “suggests or implies” a reason for a validity check issue (which it does not), Bandini does not provide any teaching whatsoever of providing a reason for a validity check issue via *a user interface on a mobile device*, as required by claim 1. Because in claim 1 the reason for the validity check issue is surfaced to the user, the user can take corrective action before the message is even sent.

The Advisory Action maintains that Bandini discloses “surfacing the validity check to the user so that the user can take corrective action before the message is even sent” based upon the following passage from paragraph 44: “[d]isposition action 620 determines whether the message should continue to the destination(s).” However contrary to this position in the Advisory Action, the “disposition action” at step 620 in the flowchart of figure 6(a) is being performed by the e-mail firewall and not by the user. This is made clear in multiple locations in Bandini: “FIG. 6(a) [which includes step 620] is a flowchart showing *operation of the e-mail firewall* 105 in response to a received message” (see paragraph 43; emphasis added); and paragraph 15 of

Bandini identifies figure 6(a) as “illustrating operation of the preferred embodiment of an e-mail firewall.” Accordingly, any alleged corrective action in Bandini is being performed by the e-mail firewall and not by the user. Whether an electronic messaging reader is a type of user-interface (as maintained in the Advisory Action) is immaterial since, as shown above, Bandini discloses that it is the e-mail firewall performing the alleged corrective action and not the user.

Thus, at least because of these differences between the cited art and claim 1, the subject matter of claim 1 is patentable and should proceed to issuance.

(II) Neither Reference Teaches That The Processing Performed With Respect To A Secure Message Occurs Before A Message Is Even Sent.

In the method of claim 1, processing of the secure message occurs before a message is even sent, thereby providing a user of the mobile device the benefit of taking steps to ameliorate the validity check issue before the secure message is sent. (Dependent claim 8 further emphasizes this aspect by canceling the sending of the message to a recipient whose certificate was not located – which operation is performed via the wireless mobile communication device.) The Final Office Action cites paragraph 44 of Bandini as disclosing this aspect of claim 1. However, paragraph 44 of Bandini is explicitly directed to the handling of e-mail messages that have already been sent by the user. Paragraph 44 discusses Figure 6(a) of Bandini. As Bandini states, “FIG. 6(a) is a flowchart showing operation of the e-mail firewall 105 in response to a ***received message***.” (Bandini, paragraph 43; emphasis added.) In Bandini, an e-mail firewall receives a message from a sender and processes the message. If an issue related to the received message is found, there is no disclosure in Bandini for providing a reason about the issue to a user interface, and the sending user thus would not have an opportunity to try to fix the issue that was identified and about which reason was provided to the user.

The Advisory Action argues that processing is performed before a message is sent by maintaining that the processing of the message in Bandini is performed before it has been delivered to the intended recipient. Assignee respectfully submits that this is an incorrect position. In general, a message is sent when a sender has activated the message send button. In Bandini, the e-mail message has already left the sender and is now being processed by the e-mail firewall as shown by the flowcharts of figures 6(a) and 6(b).

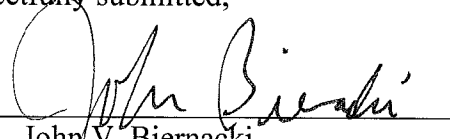
For at least this additional reason, claim 1 is patentable over the cited references and should proceed to issuance.

The Final Office Action cited the same rationale in rejecting the other independent claims. Therefore, independent claims 25-27 are patentable for at least the reasons set forth above with respect to claim 1 and should similarly proceed to issuance.

For the foregoing reasons, assignee respectfully submits that the pending claims are allowable.

Respectfully submitted,

By: _____


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